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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,683	03/04/2002	Hiroaki Matsuda	220228US0	2827

22850 7590 02/18/2004

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EXAMINER

RODEE, CHRISTOPHER D

ART UNIT PAPER NUMBER

1756

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/086,683

Applicant(s)

MATSUDA ET AL. 

Examiner

Christopher D RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/29/03 & 10/10/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 7 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10102003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Election/Restrictions***

Applicant's election with traverse of group I in Paper No. 09292003 is acknowledged. The traversal is on the ground(s) that the Examiner has not carried the burden of providing any material reasons and/or examples to support the conclusion that the claims of the restricted groups are patentably distinct. This is not found persuasive because the Examiner did provide specific reasons in the last Office action discussing why the inventions are distinct. For example, the carrier and method of using the carrier are distinct because the carrier as claimed can be used in another and materially different process such as mixing the carrier particles with a thermosetting polymer and extruding the mixture to form a solid object having color and/or conductivity as a result of the carbon black-containing carrier particles. Applicants have not specifically addressed the reasons for holding of distinctness presented by the Examiner. The simple conclusion that the Examiner has not met the requisite burden set forth in the MPEP is not persuasive because it does not address the reasons presented in the last Office action.

The requirement is still deemed proper and is therefore made FINAL. Applicant's for rejoinder of the non-elected claims is noted should the product be found allowable. The Examiner will consider rejoinder per MPEP 821.04 at the appropriate time.

Information Disclosure Statement

In the last Office action the Examiner noted that 79 different items had been submitted for consideration in the IDS. The Examiner also stated, "In an effort to clarify the "material" nature of these references to the patentability of the instant claims applicants are *requested* to specify why each of the above noted applications was cited and to highlight those documents of

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most significance to the instant claims, particularly to the claims directed to the elected invention." No remarks were submitted by applicants in response to this request.

The information disclosure statements filed December 22, 2003, November 26, 2003, and October 10, 2003 fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. No copies of the copending applications have been submitted for each IDS. All other IDS materials from the seven IDS submitted subsequent to the first Office action have been considered. Applicants are again *requested* to specify why each of the above noted copending applications was cited and to highlight those documents of most significance to the instant claims, particularly to the claims directed to the elected invention.

Claim Rejections - 35 USC §§ 102 & 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 4, and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsuda *et al.* in US Patent 6,534,232.

Claims 1, 4, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2001-027829.

Claims 2, 3, and 5 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Matsuda *et al.* in US Patent 6,534,232.

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Claims 2, 3, and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 2001-027829.

These rejections were fully set forth in the last Office action and those rejections are incorporated here.

These rejections were addressed together in the response to the first Office action and the Examiner will treat the rejections in the same manner. Applicants traverse the rejection because "Applicants' average core particle size is different from Matsuda's average core particle size. Additionally, Applicants have determined that the carbon black number average diameter (CBDN) within the coating layer is dependent upon the conditions used to prepare either the coating liquid or a given carrier material... Matsuda does not specify the conditions used to prepare the coating liquid. Therefore, the size of the carbon black particles in Matsuda's examples cannot be the same as that described in Applicants Specification, and, thus, Matsuda cannot anticipate Applicants' claimed invention." Applicants provide a detailed discussion of the importance of preparing the carrier coating layer according to the method described in the instant application. Applicants note that if the layer is not produced in the manner specified aggregates and agglomerates of the carbon black primary particles are produced. These carbon black aggregates and agglomerates have sizes larger than permitted by the instant claims. Consequently the carbon black particles in the resin layer do not anticipate or make obvious the instant claims.

The Examiner has carefully considered applicants' detailed response, including the attachments. Applicants' thorough response is appreciated. However, the rejection must be maintained because the primary particles in the reference have the requisite particle size, even if aggregated or agglomerated as discussed. As noted in the last Office action, "Matsuda exemplifies a carrier in Preparation of Carrier D (cols. 11-12) having a magnetite core and

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coated with a silicone resin and carbon black BP-2000, which is the same carbon black as exemplified in the instant specification as meeting the requirements of "carbon particles" in the instant claims." These carbon black particles have a primary particle size that meets the requirements of the instant invention. Even if aggregated or agglomerated, the primary particles in these agglomerates and aggregates still have the requisite average particle diameter. The same is true for the JP document because of its common lineage.

Applicants' remarks concerning the carrier particle diameter and the influence of this diameter on resistivity are noted. However, the claims are not limited to a specific carrier size that is outside the scope of the references' disclosures. Further, the resistivity of Matsuda is within the resistivities required of dependent claim 4 (see Matsuda: col. 4, l. 39-46).

The references remain applicable to the claims because the primary carbon black particles in the reference's carrier resin layers have a particle size that anticipates the instant claims, even if the aggregated or agglomerated. Further, there is no reason presented by applicants to establish that every carbon black particle is agglomerated or aggregated in the reference. Thus, a small number of carbon black particles remaining unagglomerated or unaggregated would still meet the requirements of the instant claims. No evidence is of record to show that the primary particle size of the carbon black changes in the resin layer formation process of the applied art, nor is there actual evidence to show that with the specific resin layer formulation of the art agglomerates and aggregates will form.

The rejections are maintained.

Claims 1 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshino *et al.* in US Patent 5,849,448.

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Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshino *et al.* in US Patent 5,849,448 in view of Shintani *et al.* in US Patent 5,204,204 and further in view of *Handbook of Imaging Systems*, to Diamond, pp. 222-224.

These rejections were set forth in the last Office action and are incorporated here. The reasons for traversal are essentially the same for the primary Yoshino reference as for Matsuda. Applicants acknowledge that Yoshino teaches that the particles added to the formulation for the resin layer have sizes within the scope of the claims. However, applicants state, based on the Kirk-Othmer citation, that these particles were agglomerate or aggregate and these agglomerates and aggregates have sizes larger than permitted by the instant claims. Applicants also state that it is impossible to tell the actual size of the carbon black particles in Yoshino's resin layer.

The Examiner must disagree with these conclusions. The exemplified carbon black particles have a primary particle size that meets the requirements of the instant invention. Even if aggregated or agglomerated during resin layer formation, the primary particles in these agglomerates and aggregates still have the requisite average particle diameter. It is possible to tell the size of the primary carbon black particles: The carbon black has an average particle size of 25 nm (0.025 μm) in Example 1 and an average particle size of 30 nm in Example 4.

The references remain applicable to the claims because the primary carbon black particles in the reference's carrier resin layers have a particle size that anticipates the instant claims, even if the aggregated or agglomerated. Further, there is no reason presented by applicants to establish that every carbon black particle is agglomerated or aggregated in the reference. Thus, a small number of carbon black particles remaining unagglomerated or unaggregated would still meet the requirements of the instant claims. No evidence is of record to show that the primary particle size of the carbon black changes in the resin layer formation

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process of the applied art, nor is there actual evidence to show that with the specific resin layer formulation of the art agglomerates and aggregates will form.

The rejections are maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on most weekdays from 6 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CHRISTOPHER RODEE
PRIMARY EXAMINER

cdr
10 February 2004